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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,260	09/09/2003	Takatoshi Mochizuki	018656-677	4033
21839 7590 09/21/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER LEWIS, ALICIA M	
			ART UNIT 2164	PAPER NUMBER
			NOTIFICATION DATE 09/21/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/657,260

Applicant(s)

MOCHIZUKI, TAKATOSHI

Examiner

Alicia M. Lewis

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 3-5,7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to the Request for Continued Examination (RCE) filed June 29, 2007. Claim 10 is currently amended. Therefore, claims 1-11 are pending in this application.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2. Claims 10 and 11 are directed to managing data files. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for assigning keywords to a data file. This produced result remains in the abstract and, thus fails to achieve the required status of having real world value.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 6, 9, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Takemoto (US Patent 6,335,742 B1).

With respect to claims 1, 6 and 11, Takemoto teaches:

a storage unit that stores folders, existing data files and keywords assigned to each existing data file (element 17 in Figure 1, column 6 lines 16-19);

an input unit (element 11 in Figure 1, column 5 lines 15-19) by which a user enters an instruction to move a new data file to a folder (column 10 lines 21-50); and

a processing unit (element 13 in Figure 1) that extracts the keywords assigned to the existing data files in the folder (Figures 4 and 19, column 11 lines 14-30) and assigns the extracted keywords to the new data file in response to the instruction (Figures 4 and 21, column 11 lines 31-52).

In Figure 4, Takemoto teaches a list of files included in the "tmp" folder. He then teaches in Figure 21 and column 11 lines 31-52 that multiple keywords may be assigned to files. For all the three files in Figure 4, the collective keywords are A, B,

and C. In Figure 21, Takemoto shows that keywords A, B and C are all selected to be assigned to the new file.

With respect to claim 2, Takemoto teaches wherein a name of the data file includes an extension showing the nature of the file (Figures 9 and 11, column 12 lines 37-39).

With respect to claim 9, Takemoto teaches further comprising an interface that receives the new data file (column 2 lines 31-37).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto (US Patent 6,335,742 B1).

With respect to claim 10, Takemoto teaches:
storing a new data file in a storage unit (element 17 in Figure 1, column 6 lines 16-19);

receiving an instruction to move a new data file to a folder (column 10 lines 21-50);

extracting keywords assigned to existing data files in the folder in response to the received instruction (Figures 4 and 19, column 11 lines 14-30); and

assigning the extracted keywords to the new data file in response to the instruction (Figures 4 and 21, column 11 lines 31-52).

Takemoto does not teach that the assigning is done automatically.

However, the MPEP states, "broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art." (See MPEP 2144.04)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Takemoto's assigning step to an automated step because of the case law found in the MPEP. The motivation to do so would be to have an automated process, which could save time and/or take the workload off of the user/administrator.

Allowable Subject Matter

7. Claims 3-5, 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed June 29, 2007 have been fully considered but they are not persuasive. Applicant argues that Takemoto fails to disclose that keywords are

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extracted or assigned in response to an instruction to move a new data file to a folder. Examiner disagrees. Takemoto teaches that keywords may be assigned or extracted at any time, therefore, the extraction and assignment of keywords can occur in response to an instruction to move a new file to a folder. The keyword registration and keyword setting are not required to happen at any particular time, in fact he teaches that keywords may be added or modified at any time (column 9 lines 12-14). Thus, it is clear that the extraction and assignment may occur in response to an instruction to move a new file to a folder.

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., automatically performing an extraction and assignment of the keyword) are not recited in the rejected claims 1 and 11. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues that "stated differently" his claim includes automated processing; however, claims 1 and 11 are not "stated differently" and do not recite any type of automated process.

10. Lastly, applicant argues that the CPU of Takemoto does not function to assign keywords to a new file, but instead a user performs this action. Examiner disagrees. Takemoto teaches that the keyword registration or assignment is executed by the CPU (column 11 lines 32-34). Furthermore, it is inherent that some type of processor or computer must perform that actual assignment. While a user may choose which keywords to assign (according to some type of interface), it is the actual machine that does the internal assigning or associating of keywords and files.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Lewis whose telephone number is 571-272-5599. The examiner can normally be reached on Monday - Friday, 9 - 6:30, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alicia Lewis
September 12, 2007


SAM RIMELL
PRIMARY EXAMINER